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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,964	03/22/2002	Akihiro Goto	Q69055	4903

23373 7590 07/14/2004

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EXAMINER

MAYEKAR, KISHOR

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/088,964	GOTO ET AL.	
	Examiner	Art Unit	
	Kishor Mayekar	1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments with respect to claims 13-15 have been considered but are moot in view of the new ground(s) of rejection.

Specification

2. The abstract of the disclosure is objected to because it does not reflect the subject matter as now claimed in claims 13-15. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 13-15 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling 1) for cBN as powder of a hard material and 2) for Co as the coat of an electrically conductive material, does not reasonably provide enablement 1) for any other material as the powder of a hard material and 2) for any other material (e.g. conductive polymer) as the coating of the electrically conductive material. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission in view of either JP 57061026 A or JP 63200465 A. Applicant admits in the paragraph crossing pages 1 and 2 that it is known in a discharge surface treatment method the use of an electrode for the discharge surface treatment obtained by using Co powder (electrical conductive powder) and compression molding the powder. The difference between the admission and the above claim is the starting with a powder of a hard material having an electrical insulating property and the coating of the powder with an electrically conductive material. JP '026 shows the coating of a plastic powder with an electrically conductive material prior to the compression molding of the coated powder (see abstract). JP '465 shows the coating of a silver oxide powder with an electrically conductive material prior to the compression molding of the coated powder (see abstract). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the admission as suggested by either the Japanese references because this would render the compressed molded product electrically conductive.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission in view of either JP '026 or JP '465 and HEI 10-130318 and ONISHI et al. (5,718,736). The admission and either the Japanese references are applied as above. The further difference is the step of heat treating the compact. HEI '318, a reference cited by Applicant, shows the above limitation in a method of manufacturing an electrode for discharge surface treatment (see abstract). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the references' teachings as suggested by HEI '318 because this would result the powder to partially melt.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admission in view of either JP '026 or JP '465 and HEI 10-130318 as applied to claim 14 above, and further in view of either ONISHI et al. (5,718,736) or SUNG (6,286,498). The further difference between the references as applied above and the instant claim is the provision of wax to the coated powder. ONISHI shows the use of wax as molding auxiliary in the method of compressing molding powders (col. 8, lines 36-46). SUNG shows the same (col. 10, lines 17-31). The

subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the reference's teachings as shown by either ONISHI or SUNG because "the use of conventional materials to perform their known functions in a conventional process is obvious". In re Raner 134 USPQ 343.

Response to Arguments

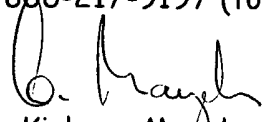
9. Applicant's arguments filed April 19, 2004 have been fully considered but they are not persuasive because of the new ground of rejections as set forth in the above paragraphs.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax

phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kishor Mayekar
Primary Examiner
Art Unit 1753